THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN H. PHILLIPSON

Appeal No. 1998-3413
Application No. 08/512,782

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7, 11, 13 through 25 and 37, which are all of the claims pending in this application. Claims 8 through 10, 12 and 26 through 36 have been canceled.

Appellant's invention relates to a method for making decorative containers, and more specifically to a method of constructing flower pots that have distinctly different decorative elements associated with the rim of the flower pot or both the rim of the flower pot and the rim of a water tray associated therewith. A copy of representative claims 1, 3, 7, 11, 13, 18 and 37 on appeal, as reproduced from the Appendix to appellant's brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Allen	340,027	Apr. 13, 1886
Coleman Jr. (Coleman)	2,785,508	Mar. 19, 1957
Blake	4,880,130	Nov. 14, 1989

Claims 3 through 7 and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Coleman.

Claims 1, 2 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coleman.

Claims 13 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coleman in view of the state of the art.

Claims 20 through 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Coleman in view of the state of the art as applied to claim 18 above, and further in view of either one of Allen and Blake.[1]

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 17, mailed June 10, 1998) for the reasoning in support of the rejections and to appellant’s brief (Paper No. 16, filed December 1, 1997) for the arguments thereagainst.

OPINION

[1] As pointed out on page 2 of the examiner’s answer, the rejections of claims 1 and 2 under 35 U.S.C. § 112, first and second paragraphs, have been withdrawn and are no longer before us on appeal.

In reaching our decision in this appeal, this panel of the Board has given careful consideration to appellant's specification and claims, to the applied prior art references, to the evidence of secondary considerations filed by appellant and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have reached the determinations which follow.

Looking first to the examiner's rejection of claims 3 through 7 and 37 under 35 U.S.C. § 102(b) based on Coleman, we are in agreement with the examiner that the plastic flower pot collar and plant protector (10) in Coleman provides a decorative feature to the ceramic flower pot (18) and that Coleman therefore broadly discloses or teaches a method of making a decorative container. Moreover, we also agree with the examiner that the side wall of the ceramic flower pot (18) of Coleman has imparted thereto in the manufacturing process thereof a first decorative characteristic (e.g., a finish, texture or color) and that the plastic collar or ring member (10) likewise has imparted thereto during manufacture a decorative characteristic (e.g., a finish, texture or color),

and further that one of ordinary skill in the art would have readily discerned that at least the finish or texture of the side wall of the ceramic flower pot is distinctly different from the finish or texture of the molded plastic collar. In this context, we also note that Coleman (col. 2, lines 37-38) indicates that the molded plastic collar or ring member (10) may be made in various colors. In addition, while we agree with the examiner that the collar or ring member (10) of Coleman, as seen in Figure 4, is dimensioned, at least in part (e.g., at 16), to fit in overlapping relationship with an outside

surface of the rim of the flower pot (18), we must agree with appellant (brief, page 23) that the locking tabs or lips (15) of Coleman's collar or ring member are not molded "at an outer extremity of the ring member" as required in claim 3 on appeal.

Coleman expressly indicates that the collar or ring member (10) includes a planar annular portion (11) with a downturned outer lip (12) and a downturned annular lip (13) at the center. Integrally formed on the underneath side of the annular portion (11) are three equally spaced supports (17). These supports are described in Coleman (col. 2, lines 16-17) as increasing in vertical height "from their outer extremities under the lip 12" and as terminating in a vertical face (16) which rests against a portion of the rim of the pot. The horizontally extending lips or locking tabs (15) of Coleman extends transversely to the vertical edge (16) and towards the central portion of the collar or ring member (10) below the downturned lip (13) so as to ride under the horizontal shoulder (18N) of the rim of the flower pot. With this analysis, it is clear to us that the locking tabs or lips (15)

in Coleman are located at the center portion of the collar or ring member (10) and not at "an outer extremity of the ring member" (i.e., at or adjacent the outer lip (12) of the ring

member of Coleman) as is required in appellant's claim 3 on appeal. For that reason, we will not sustain the examiner's rejection of independent claim 3 under 35 U.S.C. § 102(b) based on Coleman, or the same rejection of claims 4 through 6 which depend from claim 3.

Independent claim 37, like claim 3, includes a limitation concerning molding a locking tab "at an outer extremity of the ring member," and for the same reasons advanced with regard to claim 3 above distinguishes over Coleman alone. In addition, we note that claim 37 also recites that the locking tab "substantially surrounds the downwardly extending outer portion of the [rim of the] container member" and that it is locked around an extremity of the downwardly extending outer portion of the rim of the container member. While the three widely spaced locking tabs or lips (15) in Coleman clearly are locked around an extremity of the downwardly extending outer portion (18N) of the rim of the container or pot (18), they do not "substantially surround" (i.e., extend a substantial distance circumferentially around) the downwardly extending outer portion of the rim of the container member as required

in appellant's claim 37. Thus, the examiner's rejection of claim 37 under 35 U.S.C. § 102(b) will not be sustained.

As for the examiner's rejection of independent claim 7 under 35 U.S.C. § 102(b) based on Coleman, we will sustain that rejection. As we indicated above in our treatment of claim 3, we agree with the examiner that one of ordinary skill in the art would have readily discerned that at least the finish or texture of the side wall of the ceramic flower pot (18) would be distinctly different from the finish or texture of the molded plastic collar (10), thus providing response for the distinctly different first and second decorative characteristics set forth in appellant's claim 7. While it is true that Coleman does not expressly discuss the distinctive first and second decorative characteristics (e.g., finish or texture) of the ceramic pot and the molded plastic collar therein, it is our opinion that a difference in texture or finish between these two distinctly different types of components would have been an inherent characteristic recognized by one of ordinary skill in the art. We again also note that Coleman specifically indicates (col. 2, lines 37-38)

that the collar or ring member (10) can be made in a variety of colors, thereby providing another potential difference in decorative characteristics between the ceramic flower pot and the molded plastic collar or ring member.

In light of the foregoing, we agree with the examiner that the method as set forth in claim 7 on appeal is anticipated by Coleman. Thus, the examiner's rejection of claim 7 under
35 U.S.C. § 102(b) based on Coleman is sustained.

We next consider the examiner's rejection of claims 1, 2 and 11 under 35 U.S.C. § 103(a) based on Coleman. With regard to claims 1 and 2 on appeal, we agree with the examiner that it is well known in the flower pot art to make multiple pots that have generally the same shape and dimensions and to then store those pots in a nested, stacked relationship. Moreover, we agree with the examiner that the collar and pot combination seen in Figure 4 of Coleman would have been recognized by those of ordinary skill in the art as having the capability of allowing such nestible, stacked storage thereof. In that

regard, it is readily apparent from the relative sizing seen in Figure 4 of Coleman that a second pot of like shape and dimensions to the pot (18) seen in Figure 4, with or without an attached collar, would be nestible in the first pot and collar combination (10, 18) by having the bottom portion of the second pot inserted into the central opening in the collar of the first pot.

Appellant's arguments on pages 26 and 27 of the brief regarding claims 1 and 2 on appeal are not convincing, because under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests (In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)), as well for as the reasonable inferences which the artisan would logically draw from the reference. See In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). In addition, while there clearly must be some teaching or suggestion to combine existing elements in the prior art to arrive at the claimed invention, we note that it is not necessary that such teaching or suggestion be found only

within the four corners of the applied reference or references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Boezk, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), this is because we must presume skill on the part of the artisan, rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir 1985).

While it is true that Coleman does not expressly indicate that the pot and collar arrangement therein is intended to be used with another pot stored therein, we observe that the method in claim 1 on appeal does not specifically require nesting of the pots, but only sets forth a nesting capability between first and second pots of like shape and dimensions, which capability we consider to be present in Coleman's pot and collar arrangement and obvious to one of ordinary skill in the art. As for the argument regarding the "different decorative characteristics," we have treated this aspect of appellant's arguments above in our discussions of the

examiner's rejection of claims 3 and 7 based on Coleman, and refer back to that discussion here. Regarding claim 2, we view the elements (11-17) as constituting the collar or ring member (10) in Coleman and agree with the examiner that Coleman teaches the step of removably locking the ring member (10) with the rim of the first container member (18). Thus, we sustain the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103(a) based on Coleman.

Considering the examiner's rejection of claim 11 under 35 U.S.C. § 103(a) based on Coleman, we must agree with appellant (brief, page 27) that Coleman fails to teach or suggest 1) a container member forming step wherein the rim is formed with an outwardly-facing concavity like that depicted in Figure 2 of the application and 2) a forming step for the ring member wherein the ring member is formed with a downwardly-extending concavity which corresponds to the concavity of the container member rim and wherein the ring member is fitted onto the rim in an overlapping relationship. The examiner's position (answer, page 5) that the shape of the container member rim and ring member are merely a matter of

design choice, is unsupported speculation and impermissibly reads the above express limitations out of appellant's claim 11. At the very least, the above construction set forth in appellant's claim 11 on appeal would strengthen the rim of the pot and permit the type of nested storage seen in Figure 3 of the application, while the configuration of the pot seen in Coleman clearly would not. Accordingly, the examiner's rejection of claim 11 under 35 U.S.C. § 103(a) based on Coleman is not sustained.

The examiner's rejection of claims 13 through 17 under 35 U.S.C. § 103(a) based on Coleman in view of "the state of the art," is sustained. Essentially we agree with the examiner (answer, pages 5-6) that the collar or ring member (10) of Coleman is tapered and dimension at the central rim area (13) so as to permit the nesting of another container member of some given size and corresponding shape in the opening in the collar or ring member (10) and so that the side wall of the second container is in nesting, abutting relationship to the interior of the side wall of the container (18), and that it would have been obvious to one of ordinary

skill in the art at the time of appellant's invention to nest an appropriate container therein, since such a storage technique is a well known expedient in the flower pot art. Contrary to appellant's argument (brief, page 29), while Coleman does not expressly describe nesting of the containers therein, such nesting is well known in the art for permitting storage of flower pots within a minimum of storage space, and the collar or ring member (10) of Coleman is sized and dimensioned so as to permit or facilitate such nesting with an appropriately sized second container.

Our position on the first and second "decorative characteristics" set forth in claims 14 and 15 on appeal is abundantly clear from our discussions of Coleman and this issue above. As for the requirements of claims 16 and 17 on appeal regarding the formation of a locking tab "at an extremity of the ring member" and the formation of the locking tab so as to form a camming surface at "an extremity" of the ring member, we consider that these features are clearly present in Coleman. As can be readily seen in Figures 3 and 4 of Coleman, the locking tabs or lips (15) of the collar or

ring member (10) are located at the lower "extremity" of the ring member and include a camming surface at the lower extremity which permits sliding of the camming surface along the outer surface of the flower pot rim and engagement of the locking tabs or lips (15) under the shoulder (18N) of the rim. Unlike appellant's claim 3 above, claims 16 and 17 on appeal do not require that the locking tabs be formed at an outer extremity of the ring member, but merely set forth that such tabs are formed at an extremity of the ring member (e.g., in the case of Coleman, at the lower extremity of the collar or ring member 10).

Regarding the examiner's rejection of claims 18 and 19 under 35 U.S.C. § 103(a) based on Coleman in view of "the state of the art," we observe that independent claim 18 sets forth the step of molding a rim of a flower pot with the rim defining a continuous radius (e.g., 28 in application Fig. 2) at the upper extremity of the side wall (14) of the pot and extending downwardly along the outside of the side wall of the flower pot (see rim 26 in Fig. 2). In addition, this claim requires the step of molding a decorative resilient ring

member (32) that is "dimensioned to fit in overlapping relationship with the radius of the rim and across an outside surface of the downwardly extending portion of the rim." Again, we direct attention to Figure 2 of appellant's application for an understanding of this claimed subject matter. Like appellant, we find nothing in Coleman that is in any way responsive to the formation of the particular rim structure required in claim 18 on appeal or to the particular ring member molded and dimensioned to correspond thereto. Thus, even if we can agree with the examiner (answer, page 6) that it would have been obvious to one of ordinary skill in the art to provide the flower pot of Coleman with a well known water tray dimensioned to receive the bottom of the flower pot, the resulting combination would not result in the particular method set forth in independent claim 18 on appeal. Nothing in Coleman teaches or suggests the formation of a rim that has both a continuous radius at the upper extremity of the side wall of a flower pot and a portion extending downwardly along the outside of the side wall of the flower pot as seen in appellant's Figure 2, or the formation of a ring member that corresponds to the shape of the rim in the

manner set forth in appellant's claim 18. Thus, the examiner's rejection of claims 18 and 19 under 35 U.S.C. § 103(a) based on Coleman in view of "the state of the art" will not be sustained.

We have additionally reviewed the references to Allen and Blake applied by the examiner against dependent claims 20 through 25 on appeal under 35 U.S.C. § 103(a). However, we find nothing in either of these references, or in the examiner's attempted combination thereof with Coleman, that accounts for formation of the particular rim structure and ring member required in appellant's independent claim 18, or renders such formation steps obvious to one of ordinary skill in the art. Accordingly, the examiner's rejection of claims 20 through 25, which depend from claim 18, will not be sustained.

In our deliberations leading to our affirmance of the examiner's rejections of claims 1, 2 and 13 through 17 under 35 U.S.C. § 103(a), we have considered both the teachings of the prior art applied by the examiner and the evidence of

secondary considerations submitted by appellant in the affidavit of Susan Kiley. In weighing all of this evidence together, we have concluded that the evidence of obviousness relied upon by the examiner outweighs the evidence of secondary considerations (i.e., commercial success) contained in Ms. Kiley's affidavit. While the affidavit indicates sales of the TERRAGLAZE product of "approximately $4.5 million" in the fiscal year ending September 30, 1996 and sales through February 1997 of "approximately $2.5 million," along with "modest advertising expenses" of only about $60,000 in FY 96, we find no evidence in the record of the actual impact of the claimed subject matter on the marketplace, i.e., we note that sales figures alone are of no moment when there has been no nexus established between the sales and the features of the claimed invention. See, In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); In re Baxter Travenol Lab., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991; and Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861 (Fed. Cir. 1983). While Ms. Kiley has indicated in paragraph 8 of her affidavit that a buyer told her that the TERRAGLAZE product "was the most unique offering in the

planter industry in the last 5 years," we have no evidence in this record as to exactly why the buyer in question was of that opinion, and no evidence that the opinion of the buyer was the result of the unique features of the claimed subject matter.

Moreover, with further regard to appellant's assertions of commercial success, while it is true that there is evidence of record that sales approximating 4.5 million dollars worth of the TERRAGLAZE product were made in FY 96 and additional sales in the millions were made in the first half of FY 97, we note that such sales figures alone are entitled to little weight in the absence of other evidence regarding a defined market, appellant's market share, growth in the market, or replacement of earlier units sold by others or by appellant, and evidence of nexus between the sales made and the invention's merits. See Kansas Jack, Inc. v. Kuhn, supra. Accordingly, on this record, we find that appellant’s proffered evidence of commercial success is entitled to little weight in the overall determination of obviousness of the

claimed subject matter as set forth in claims 1, 2 and 13 through 17 on appeal.

Appellant's arguments concerning secondary considerations, like commercial success, are of no moment with respect to the rejection of claim 7 under 35 U.S.C. 102(b) and have not been considered with respect thereto. See In re Fracalossi, 681 F.2d 792, 793-94, 215 USPQ 569, 570 (CCPA 1982) and In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974).

To summarize, we have reversed the examiner's rejection of claims 3 through 6 and 37 under 35 U.S.C. § 102(b) based on Coleman, but have affirmed the rejection of independent claim 7 on that basis. We have also affirmed the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103(a) based on Coleman and that of claims 13 through 17 based on Coleman and the state of the art. However, we have refused to sustain the examiner's rejection of claim 11 under 35 U.S.C. § 103(a) based on Coleman and the examiner's rejections of claims 18 through 25 under

35 U.S.C. § 103(a). Thus, the decision of the examiner is affirmed-in-part.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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Claims

1. A method for making decorative containers, comprising the steps of:

forming a first container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim having a downwardly extending outer portion and a radius at the top of the side wall;

forming a second container member having a side wall and shape and dimensions like the first container so as to be nestible therewith;

imparting a first decorative characteristic to the first and second container member side walls;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in overlapping relationship with an outside surface of the rim of the first container member, the decorative ring member forming step further comprising the steps of molding an overlapping lip portion and dimensioning the overlapping lip portion to both overlap the radius of the rim of the first container member and also avoid interference between the ring member and the side wall of the second container member when extending in nesting relationship inside of and in contact with the side wall of the first container member;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic being distinctively different from the first decorative characteristic imparted to the side wall of the first container member; and

fitting the ring member onto the rim in an overlapping relationship.

3. A method for making a decorative container, comprising the steps of:

forming a container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim having a downwardly extending outer portion;

imparting a first decorative characteristic to the container side wall;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in overlapping relationship with an outside surface of the rim;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic imparted to the side wall;

fitting the ring member onto the rim in an overlapping relationship; and

molding a locking tab at an outer extremity of the ring member, and locking the tab around an extremity of the downwardly extending outer portion of the rim.

7. A method for making a decorative container, comprising the steps of:

forming a container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim having a downwardly extending outer portion;

imparting a first decorative characteristic to the container side wall;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in overlapping relationship with an outside surface of the rim;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic being distinctively different from the first decorative characteristic imparted to the side wall;

fitting the ring member onto the rim in an overlapping relationship; and

wherein the first and second decorative characteristic imparting steps comprise the step [sic, of] selecting at least one distinctly different finish, texture or color for the container side wall and the ring member.

11. A method for making a decorative container, comprising the steps of:

forming a container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim having a downwardly extending concave outer portion;

imparting a first decorative characteristic to the container side wall;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in overlapping relationship with an outside surface of the rim;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic being distinctively different from the first decorative characteristic imparted to the side wall;

fitting the ring member onto the rim in an overlapping relationship; and

wherein the container member forming step comprises the step of forming the rim with an outwardly-facing concavity, and wherein the ring member forming step comprises the step of forming the ring member with a downwardly-extending concavity which corresponds to the concavity of the container member rim outer portion.

13. A method for making a decorative container, comprising the steps of:

forming a container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim molded so as to form a radius at the top of the side wall and having a downwardly extending outer portion;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in an overlapping relationship with an outside surface of the container member rim, the ring member tapered and dimensioned so as to permit the container member side wall to receive another container member in nesting relationship therewith;

removably fitting the ring member onto the rim in overlapping relationship; and then

nesting another container having a side wall within the container member so that the side walls thereof are in a nesting, abutting relationship.

18. A method for making a decorative flower pot and water tray combination, the method comprising the steps of:

molding a flower pot having an enclosed bottom and a side wall with a rim around an upper extremity of the side wall, the rim defining a continuous radius at the upper extremity of the side wall and extending downwardly along the outside of the side wall;

imparting a first decorative characteristic to the container side wall;

molding a decorative resilient ring member dimensioned to fit in overlapping relationship with the radius of the rim and across an outside surface of the downwardly extending portion of the rim;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic being distinctively different from the first decorative characteristic imparted to the side wall;

fitting the ring member onto the rim in an overlapping relationship; and

molding a water tray dimensioned to receive the bottom of the flower pot.

37. A method for making a decorative plant container comprising the steps of:

forming a container member having an enclosing side wall with a rim around an upper extremity of the side wall, the rim having a downwardly extending outer portion and a radius at the top of the side wall;

imparting a first decorative characteristic to the container side wall;

forming a decorative ring member and dimensioning at least a portion of the ring member so as to fit in overlapping relationship with an outside surface of the rim by molding an overlapping lip portion and dimensioning the overlapping lip portion to both overlap the radius of the rim and also avoid interference between the ring member and another container member extending in nesting relationship inside of the side wall;

imparting a second decorative characteristic to an outside surface of the ring member, the second decorative characteristic being distinctly different from the first

decorative characteristic imparted to the side wall of the container member; and

fitting the ring member on to the rim in an overlapping relationship and molding a locking tab at an outer extremity of the ring member with substantially surrounds the downwardly extending outer portion of the container member and locking the tab around an extremity of the downwardly extending outer portion of the rim of the container member.

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AFFIRMED-IN-PART

Prepared: February 5, 2001